

No. 15418

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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BERNARD H. STAUFFER,

*Appellant,*

*vs.*

SLENDERELLA SYSTEMS OF CALIFORNIA, INC.,

*Appellee.*

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APPELLANT'S OPENING BRIEF.

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**APPELLANT'S OPENING BRIEF.**

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This is an appeal from the judgment of the District Court for the Southern District of California (Tolin, Judge) dismissing an action for patent infringement [R. 50]. Judgment was entered on findings and conclusions [R. 48-50] based upon an oral opinion at the close of trial [R. 380-381] that Claim 1 of Stauffer Patent No. 2,240,679 is invalid.

**Jurisdiction.**

This suit arises under the patent laws. Jurisdiction of the District Court is founded on 28 U. S. C. 1338. Appellate jurisdiction of this Court is based upon 28 U. S. C. 1291. Judgment was entered November 27, 1956. This appeal was taken December 12, 1956, within the statutory period.

### Statement of the Case.

Stauffer Patent No. 2,240,679 in suit relates to a muscle relaxing machine of the type used for treating patients with "Passive Exercise," and it is plaintiff's contention that such machines are used throughout the entire nation in the well-known Stauffer System and Slenderella System reducing salons. The patent [R. 392] is indeed simple. Briefly summing it up, it comprises a couch 10 with an opening in it in which an applicator, denominated a seat 18, extends which is carried by legs 20 which rock about pivots 21 when driven by motor 50 through belt 52, pulley 48 and pitman 28.

The accused structures are shown by physical Exhibits 16-19, inclusive, and in each case are found to be couches with an opening, in which are mounted applicators carried by legs which are rocked through small arcs by a pitman driven by a belt system and electric motor.

The pleadings are complicated by the presence of a counterclaim under the Antitrust Laws and the addition of another party, but this counterclaim was dropped during the trial [R. 337], so all that remains in the case is a simple complaint for infringement by plaintiff Stauffer against defendant Slenderella Systems of California, Inc., and a counterclaim for declaratory relief against the patent.

Claim 1 only of the patent is relied upon. It reads as follows:

"1. A muscle relaxing machine comprising a couch-like structure for repose of a human body in



the top surface of which a slot-way is formed and through which a vertically directed and oscillatable support for a single flat rectangular applicator is adapted to tiltingly move, and means to oscillate said applicator axially of the length of said couch-like structure whereby zonular areas of the body may be massaged by mechanical manipulation in a substantially horizontal plane.”

The District Court made no ruling as to infringement of this claim, contenting itself with its finding of invalidity.

The evidence shows that Lawrence Mack, President of defendant, prior to the alleged infringement, was a holder of Stauffer franchises [R. 127] and in fact was manager in Chicago, Illinois, of Stauffer's personally owned salons [R. 128]. This association ended in litigation which was terminated by mutual releases January 25, 1953 [Pltf. Ex. 15].

The gist of the lower Court's decision is:

“Now, this art is a simple art, and the court feels that it is so simple that the structure which has been developed here by Mr. Stauffer is a structure which could reasonably be expected to have been developed by one having ordinary skill in that art and that it just does not rise to the level of invention, as invention is protected by the patent laws.” [R. 380-381.]

It is appellant's contention that this is erroneous, and that far from mitigating against invention under the patent laws of this country, “Simplicity is the highest trait of genius.”

### Specification of Errors.

The errors relied upon and urged in the appeal are as follows :

“I.

“The District Court erred in finding that Claim 1 of said Letters Patent No. 2,240,679 in suit defines an assemblage of elements all of which were old in the prior art in which they operated in substantially the same way to produce substantially the same result, and such subject matter as a whole would have been obvious to and could have been produced by any person having ordinary skill in the art to which said subject matter pertains.

“II.

“The District Court erred in finding that Claim 1 of said Letters Patent No. 2,240,679 is wanting in invention.

“III.

“The District Court erred in failing to find that Claim 1 of Letters Patent No. 2,240,679 is infringed by defendant by the use of tables by defendant exemplified by plaintiffs Exhibits 16 and 17.

“IV.

“The District Court erred in concluding that Claim 1 of said Letters Patent No. 2,240,679 is invalid and void in law for lack of invention.

“V.

“The District Court erred in concluding that the defendant, Slenderella Systems of California, Inc., is entitled to judgment against the plaintiff, Bernard H. Stauffer, dismissing the complaint with prejudice.

“VI.

“The District Court erred in concluding that the defendant, Slenderella Systems of California, Inc., is entitled to judgment on its first counterclaim herein for declaratory relief, adjudging claim 1 of said Letters Patent No. 2,240,679 in suit invalid and void.

“VII.

“The District Court erred in failing to conclude that Claim 1 of Letters Patent No. 2,240,679 is valid.

“VIII.

“The District Court erred in failing to conclude that Claim 1 of Letters Patent No. 2,240,679 is infringed by defendant by the use of tables by defendant exemplified by plaintiff’s Exhibits 16 and 17.

“IX.

“The District Court erred in ordering, adjudging and decreeing that Claim 1 of United States Letters Patent No. 2,240,679 is invalid and void in law.

“X.

“The District Court erred in dismissing the complaint and ordering that the plaintiff shall take nothing by his complaint herein.

“XI.

“The District Court erred in ordering, adjudging and decreeing that the First Counterclaim for declaratory relief adjudging Claim 1 of United States Letters Patent No. 2,240,679 invalid and void is hereby sustained.

“XII.

“The District Court erred in failing to adjudge that Claim 1 of Letters Patent No. 2,240,679 is valid and infringed by defendant.”

### Summary of Argument.

The District Court erred in concluding that the Stauffer device is too simple to be an invention.

Simplicity does not mitigate against invention as is shown by an unbroken line of cases beginning with United States Patent No. 68, *Ryan v. Goodwin*, Fed. Cas. 12186, and including the Design Patent for a license plate holder upheld by this Court April 5, 1957, *Robert W. Brown & Co., Inc. v. De Bell*, 113 U. S. P. Q. 172, in all of which extremely simple devices were found to be inventions.

The District Court erred in failing to apply the rule that where the purpose and result of the patented device are different, very slight structural changes over the prior art may be enough to support a patent.

The District Court erred in failing to find that having created a wholly new system of passive exercise, inherent in the use of the patented device, which system has swept over the entire country, the patent should be supported because of the merit of what it does.

The District Court erred in failing to find infringement of Claim 1. Each and every element of claim 1 is found in the accused devices performing the identical functions.

## ARGUMENT.

### The District Court Erred in Concluding That the Stauffer Device Is Too Simple to Be an Invention.

The District Court did not find that the patented device was anticipated by the prior art, or did not involve invention over the prior art. It rejected the prior art [R. 380]. It simply found the patented device too simple to be an invention. This is error.

That simplicity does not mitigate against invention under the patent laws of the United States is one of the most clearly settled doctrines of that law.

We may ask, is the Stauffer device more simple than: ordinary barbed wire, *The Barbed Wire Patent*, 143 U. S. 293; or the one-piece metal collar button, *Krementz v. S. Cottle Co.*, 148 U. S. 556; or the cotton belt sustained in *Gandy v. Main Belting Co.*, 143 U. S. 587; or the clay pulverizer (a cylinder with longitudinal bars), *Potts v. Creager*, 155 U. S. 597; or the round-headed nail conventionally driven in chair legs in place of castors, *Barry v. Harpoon Castor Mfg. Co.*, 209 Fed. 207 (2 Cir.); or the idea of letting envelopes seal themselves under their own weight when stacked, *Postage Meter Co. v. Standard Mailing Machine Co.*, 9 F. 2d 19 (1 Cir.); or the method of printing motion picture titles sustained in *Lane v. Craftsmen Film Laboratories*, 7 F. 2d 288 (2 Cir.); or the wooden steering wheel, *Inland Mfg. Co. v. American Wood Rim Co.*, 14 F. 2d 657 (6 Cir.); or the well-known lady's hat box, *Brick v. A. I. Namm & Sons*, 22 F. 2d 693, affirmed *Per Curiam*, 22 F. 2d 697 (2 Cir.); or the ear tag for cattle, *Jensen-Salsbery Laboratories v. Salt Lake Stamp Co.*, 28 F. 2d 99 (8 Cir.); or making one arm of an old machine out of aluminum rather than cast

iron, *United Shoe Machinery Corp. v. E. A. Ferree Co.*, 64 F. 2d 101 (2 Cir.); or a stocking protector consisting of two pieces of leather sewed together at an angle, *Silver-Brown Co. v. Sheridan*, 71 F. 2d 935 (1 Cir.); or the conical hole in a picker stick of a loom to keep the nose of the shuttle from hitting bottom, *McKee v. Graton & Knight Co.*, 87 F. 2d 262 (4 Cir.); or attaching an arm in an electric clock so that it is magnetically held up by the motor, but drops into view on a current failure, *Warren Telechron Co. v. Waltham Watch Co.*, 91 F. 2d 472 (1 Cir.); or substituting a bourdon tube for a lever, *Baldwin-Southwark Corp. v. Tinius Olsen Testing Mach. Co.*, 88 F. 2d 910 (3 Cir.); or the match of United States Patent No. 68, covering a combination of phosphorus, chalk and glue, concerning which Mr. Justice Story charged a jury "The Combination is apparently very simple; but the simplicity of an invention, so far from being an objection to it, may constitute its great excellence and value," *Ryan v. Goodwin*, Fed. Cas. 12186, or the license plate frame this Court sustained in *Robert W. Brown & Co. v. De Bell*, 113 U. S. P. Q. 172, April 5, 1957?

Each of the cases cited above unequivocally holds that simplicity does not mitigate against invention, and this Court has announced that "It is quite apparent that simplicity alone will not preclude invention," *Patterson-Bal-lagh Corp. v. Moss*, 201 F. 2d 403 (9 Cir.).

Indeed, many cases have taken the view that "To obtain simplicity is the highest trait of genius," *Aronson v. Toy Devices, Inc.*, 1 F. 2d 91 at 92 (3 Cir.).

It seems abundantly clear that the District Court was not following the law when it held that the Stauffer device was just too simple to be an invention.

The District Court Erred in Failing to Apply the Rule That Where the Purpose and Result Are Different, Very Slight Structural Changes Over the Prior Art Are Enough to Sustain a Patent.

The patent in suit discloses a mechanism which when used as intended imparts passive exercise to the human body. Mr. Stauffer described this as follows:

“The Witness: The applicator that is carrying the weight induces a traction effect on the part of the body that is stationary. The weight of the body carried by the applicator causes a stretching effect between those areas of the body that are stationary, carried by the couch.

“And it is between this action and this weight of the body, carried on the couch, that you get the stretching effect or the traction in the various muscle areas.”

No prior art apparatus which functions in this way or achieves this result has been produced.

Perhaps, by modification, the Miller device, Exhibit D-1 [R. 451], could be made to so function, but this is immaterial. As said in the very oft cited case of *Topliff v. Topliff*, 145 U. S. 156, 36 L. Ed. 661:

“\* \* \* While it is possible that the Stringfellow and Surles patent might, by a slight modification, be made to perform the function of equalizing the springs which it was the object of the Augur patent to secure, that was evidently not in the mind of the patentees, and the patent is inoperative for that purpose. Their device evidently approached very near the idea of an equalizer; but this idea did not apparently dawn upon them, nor was there anything in their patent which would have suggested it to a

mechanic of ordinary intelligence, unless he were examining it for that purpose. It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.”

Another expression of the rule was made by Judge Learned Hand in *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 18 F. 2d 66, at 68 (2 Cir.), cert. den. 274 U. S. 753:

“\* \* \* If the thing itself be new, very slight structural changes may be enough to support a patent, when they presuppose a use not discoverable without inventive imagination. We are to judge such devices, not by the mere innovation in their form or material, but by the purpose which dictated them and discovered their function.”

Recently this Court stated in *Pointer v. Six Wheel Corporation*, 177 F. 2d 153 (9 Cir.) at 160-161:

“A test which has been found very useful and generally followed is that adverted to by Mr. Chief Justice Taft in the case just referred to,—namely, the discovery of the source of the difficulty and the application of a remedy not thought of before.” (Citing cases.)

\* \* \* \* \*

“Of course, if in solving the difficulty, the inventor merely does what would have been manifest to one skilled in the art, merely substitutes an obvious element for another, or recombines old elements, there is no invention.” (Citing cases.)

\* \* \* \* \*



“By the same token, invention cannot be defeated merely by showing that, in one form or another, each element was known or used before.” (Citing cases.)

\* \* \* \* \*

“The question is: Did anyone before think of combining them in this manner in order to achieve the particular unitary result,—a new function? *If not, there is invention.*” (Citing cases.)

\* \* \* \* \*

“At times, the result is accomplished by means which seem simple afterwards. But, although the improvement be slight, there is invention, unless the means were plainly indicated by the prior art. \* \* \*” (Citing cases.)

The Stauffer invention meets these tests. While it seemed simple afterwards to the District Court, it performed a new function and achieved a new result. These are the indicia of invention.

It would unduly extend this argument to continue citing other instances where this and other courts have similarly applied these rules, so it should suffice to summarize that the Stauffer invention is new as recognized by the District Court [R. 380]. It functioned in a new manner, *i.e.*, as explained by Mr. Stauffer, *supra*, and achieved a new result, passive exercise. Invention is thus demonstrated.

We believe that this is a clear case, but if we are wrong, and it is a close case, then the Court should give weight to the phenomenal commercial success of the Stauffer System, based upon the invention of the patent in suit and of the Slenderella System, based upon defendant's infringement.

Starting with one salon in Los Angeles in 1938, the Stauffer System expanded rapidly until in 1946, they had 200 salons spread across the nation [R. 99-100]. The Stauffer System embodies use of the patented invention [R. 102-103].

We shall demonstrate *infra* that the tables used in the Slenderella System are not only infringements of the patent in suit but were copied from Stauffer tables by Lawrence Mack, a once trusted employee of the plaintiff. Slenderella System is international. We thus have a case where the plaintiff utilizing his invention and the defendant pirating it have both enjoyed phenomenal commercial success, which, under the well-known rule, is enough to resolve the question of invention in favor of plaintiff in a close case.

*Research Products v. Tretolite Co.*, 106 F. 2d 530 (9 Cir.);

*Pointer v. Six Wheel*, 177 F. 2d 153 (9 Cir.);

*Stebler v. Riverside Heights Orange Growers' Association*, 205 Fed. 735 (9 Cir.);

*Smith v. The Dental Vulcanite Co.*, 93 U. S. 486.

Finally, though defendant denies that the Stauffer device is an invention, it imitates it—why? We think the language of the court in *Kurtz v. Belle Hat Lining Co.*, 280 Fed. 277, 281 (2 Cir.), most apt:

“The imitation of a thing patented by a defendant, who denies invention has often been regarded, perhaps especially in this Circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think.”

## The District Court Erred in Failing to Find Infringement of Claim 1.

Each and every element of Claim 1 is present in the accused devices exactly as it is present in the patented invention. The accused structures are depicted in the drawings, Exhibits 16 and 17 and the Kinematic models thereof, Exhibits 18 and 19.

Exhibit 17 differs from Exhibit 16 only in minor points as stated by defendant's expert, Dr. Knapp [R. 218]. This witness applied numbers to the various parts of Exhibit 16, and using those, Claim 1 is applied to Exhibit 16 as follows:

### CLAIM 1.

A muscle relaxing machine comprising a couch-like structure for repose of the human body

in the top surface of which a slot-way is formed

and through which a vertically directed and oscillatable support

for a single flat rectangular applicator

is adapted to tiltingly move

### EXHIBIT 16.

The couch is given no number, but view I is a side view of the couch [R. 208]

There obviously has to be an opening in which the arms and pads can move

arms 11, 11A

pads 10

arms 11 pivot or tilt about bearing 12

CLAIM 1.

and means to oscillate said applicator axially of the length of said couch-like structure whereby sonular areas of the body may be massaged by mechanical manipulation in a substantial horizontal plane.

EXHIBIT 16.

connecting rod 17 and cam 21 are driven by a motor and pulley [R. 215] to oscillate the arms 11, 11A in planes extending longitudinally of the couch.

Infringement is thus clearly established. Indeed, defendant has used little imagination but uses the very same mechanical elements as plaintiff, *i.e.*, motors, pulleys, cams, pitmans, pivoted arms and substantially horizontal applicators.

Nor is this surprising when we recall that defendant's President, Lawrence Mack, learned this business as a franchise holder and salon manager of plaintiff. He merely copied what he had been furnished by plaintiff, and he did this while he was still managing Stauffer's Chicago operations [R. 128-129].

This is a clear case of deliberate, wilful infringement.

**Conclusion.**

In conclusion it is respectfully submitted that the sole basis for the District Court's decision, *i.e.*, that the apparatus of the patent in suit is too simple to be an invention, involves a basic error in law and must be reversed. The patent in suit discloses a device which functions in a new way to achieve a new result, the manipulating of a zonular area of the human body against the weight of the remainder of the body supported on a couch to thus achieve passive exercise. That under such circumstances,

the invention may lie in the discovery of the idea and that very slight structural differences from the prior art are enough to sustain the patent and that it is immaterial that by modification the prior art might be made to perform this function where the prior art was not designed, adapted or used to perform such function.

That the patent in suit has enjoyed a remarkable commercial success, not only in the form commercialized by the plaintiff but in the form pirated by the defendant, which should be enough to resolve any lingering doubts as to invention.

Finally, Claim 1 of the patent in suit is clearly applicable to the accused device and the infringement in this case has been flagrant, willful and deliberate. Accordingly, this Court should enter a decree reversing the District Court and ordering judgment in favor of the plaintiff that Claim 1 of the patent in suit is valid and has been infringed by the defendant.

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